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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/585,472 | 06/02/2000 | Michiaki Sakamoto | 157330/99 | 6609 |
| 21254 | 7590 | 10/21/2003 | EXAMINER | |
| MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817 | | | RUDE, TIMOTHY L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2871 | |

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/585,472

Applicant(s)

SAKAMOTO, MICHIAKI

Examiner

Timothy L Rude

Art Unit

2871

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 13 August 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 2, 4-7, 9-11 and 17 are amended.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 6-10 and 17-22, drawn to a method of manufacturing an active matrix liquid crystal display, classified in class 349, subclass 187.
- II. Claims 1-5 and 11-16, drawn to an active matrix liquid crystal display device, classified in class 349, subclass 106.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case (2) the display can be made with color filters formed by an ink-jet process (as opposed to the photosensitive color resist of base claims 6 and 7) and the display can be made by forming a single contact hole subsequent to forming the color filter (as opposed to the first and second holes of base claim 17).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Invention I contains claims directed to the following patentably distinct species of the claimed invention:

Species A, claims 6-10, Figures 6a-6e, drawn to a method of manufacturing an active matrix liquid crystal display of embodiment two comprising: forming a contact hole by patterning a color filter and forming a pixel electrode connected to an electrode of a transistor through said contact hole.

Species A contains claims directed to the following patentably distinct sub-species of the claimed invention:

Sub-species AA, Figure 3b, claim 6, drawn to a method of manufacturing an active matrix liquid crystal display device comprising: forming pixel electrodes on color filters.

Sub-species AB, Figure 5b, claims 7-10, drawn to a method of manufacturing an active matrix liquid crystal display device comprising: forming pixel electrodes on an overcoat layer.

Species B, claims 17-22, Figures 4a-4d, drawn to a method of manufacturing an active matrix liquid crystal display of embodiment one comprising: forming a first hole in a passivation film and forming a color filter having a second hole and forming a pixel electrode connected to an electrode of a transistor through said first and second holes.

Species B contains claims directed to the following patentably distinct sub-species of the claimed invention:

Sub-species BA, Figure 3b, claims 17-20 and 22, drawn to a method of manufacturing an active matrix liquid crystal display device comprising: forming pixel electrodes on color filters.

Sub-species BB, Figure 5b, claim 21, drawn to a method of manufacturing an active matrix liquid crystal display device comprising: forming pixel electrodes on an overcoat layer (Applicant's inserting an overcoat layer between said color filter and said pixel electrode). Please note examiner considers Applicant's claim 21 to be improperly stated for a method claim and currently improperly dependent on an alternate sub-species.

Invention II contains claims directed to the following patentably distinct species of the claimed invention:

Species C, claims 1 and 3-5, drawn to an active matrix liquid crystal display device comprising: a pixel electrode connected to a thin film transistor through a contact hole.

Species D, claims 11-16, drawn to an active matrix liquid crystal display device comprising: a pixel electrode connected to a thin film transistor through first and second holes.

Species D contains claims directed to the following patentably distinct sub-species of the claimed invention:

Sub-species DA, Embodiment one, Figure 3b, claims 11-14 and 16, drawn to an active matrix liquid crystal display device comprising: pixel electrodes on color filters.

Sub-species DB, Embodiment two, Figure 5b, claim 15, drawn to an active matrix liquid crystal display device comprising: pixel electrodes on an overcoat layer. (Applicant's an overcoat layer inserted between said color filter and said pixel electrode). Please note examiner considers Applicant's claim 15 to be

improperly stated for a device claim and currently improperly dependent on an alternate sub-species.

Applicant is required under 35 U.S.C. 121 to elect species C or a single disclosed sub-species, AA, AB, BA, BB, DA, or DB for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are considered generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy L Rude whose telephone number is (703) 305-0418. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert H Kim can be reached on (703) 305-3492. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.

Timothy L Rude
Examiner
Art Unit 2871

TLR

*Timothy L Rude
T-Chandhury
Primary Examiner*